Tiffany (NJ) Inc. et al v. eBay Inc. Doc. 62

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

TIFFANY (NJ) INC. and TIFFANY AND COMPANY, **Plaintiffs,** **v.** **eBAY INC.,** **Defendant.**	**Case No. 04 Civ. 4607 (KMK)** **DECLARATION OF RANDI W. SINGER**

I, Randi W. Singer, declare, under penalty of perjury, as follows:

1. I am admitted to practice before this Court and am a member of the law firm Weil, Gotshal & Manges LLP, which represents eBay Inc. ("eBay") in the above-captioned action. I submit this declaration on behalf of eBay in further support of eBay's motion in limine to exclude evidence that purports to create liability based on trademarks first asserted in Tiffany's Proposed Findings of Fact.

2. The purpose of this declaration is to place before the Court certain documents referenced in eBay's accompanying memorandum in further support of its motion in limine, and to describe the relevant history of this litigation with respect to the issues pertaining to the motion. Except where otherwise indicated, I have personal knowledge of the facts set forth in this declaration.

3. Exhibit A hereto is a true and correct copy of a letter from James B. Swire, outside counsel for Tiffany, to Jay Monahan, in-house counsel for eBay, dated May 14, 2003. In that letter, sent approximately one year before Tiffany filed the present litigation against eBay, Mr. Swire states: "We represent Tiffany (NJ) Inc. and Tiffany Company (collectively "Tiffany"), owner and licensee, respectively, of the federally registered TIFFANY® trademark (and its

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variant TIFFANY & CO.®) for use in connection with a wide variety of goods and services." In the letter, Mr. Swire makes no mention of any other trademarks, including the eleven trademarks Tiffany first identified in its Proposed Findings of Fact.

4. In Tiffany's First Amended Complaint, dated July 14, 2004 ("Complaint"), Tiffany specifically refers only to the "Tiffany," "Tiffany & Co.," and "T & Co." trademarks. The Complaint never uses the words Atlas, Elsa Peretti, or Paloma Picasso, or any variations thereof. Representative excerpts of the Complaint are as follows:

- "Tiffany (NJ) is the proprietor of the TIFFANY, TIFFANY & CO., and T & CO. trademarks at issue herein." Complaint at ¶ 2.
- "TIFFANY and its variant TIFFANY & CO. are recognized as among the most famous trademarks in the United States and around the world and represent a great and valuable goodwill owned by Tiffany." Complaint at ¶ 7.
- "Tiffany [is] a purveyor of high quality goods . . . under the trademark and trade name TIFFANY and its variant TIFFANY & CO." Complaint at ¶ 8.
- "In the past decade, Tiffany's sales of goods bearing, or marketed under, the TIFFANY name in the United States, including the State of New York, have exceeded $12.1 billion at retail." Complaint at ¶ 9.
- "eBay, in common with a majority of the public, is well aware of the TIFFANY and TIFFANY & CO. trademarks and of the vast goodwill represented and symbolized thereby." Complaint at ¶ 21.
- "On these greeting pages are listings entitled 'Tiffany & Co.' or 'Tiffany' – plaintiffs' famous, registered trademarks." Complaint at ¶ 26.
- "On or about May 14, 2003, counsel for Tiffany sent eBay a letter . . . requesting that eBay . . . cease using any 'Tiffany' identifier to label counterfeit goods." Complaint at ¶ 31.
- "In 2004, Tiffany implemented a program to purchase, at random through eBay auctions, certain silver jewelry items that used the TIFFANY trademark as part of their auction titles or descriptions." Complaint at ¶ 38.
- "eBay [has] used the TIFFANY and TIFFANY & CO. trademarks." Complaint at ¶ 39.

5. Exhibit B hereto is a true and correct copy of the First Request for the Production of Documents by Defendant eBay Inc. (Oct. 25, 2004). In these document requests, eBay defined the term "Tiffany Marks" to mean, in relevant part, any trademark "that includes 'TIFFANY' or 'TIFFANY & COMPANY' or 'T & CO.' or Plaintiffs' trademarked designs, including, but not limited to, all trademarks owned or exclusively licensed by Plaintiffs *containing the mark TIFFANY*." Id. at Definitions ¶ 4 (emphasis added). eBay used this definition in each of its sets of document requests and interrogatories, and Tiffany never objected nor otherwise indicated that the definition was inconsistent with its conception of which trademarks were at issue in the litigation.

6. Exhibit C hereto is a true and correct copy of Plaintiffs' First Request for the Production of Documents and Things to Defendant eBay, Inc. (Oct. 22, 2004). In that Request, Tiffany defines "Tiffany Marks" as "the trademarks TIFFANY, TIFFANY & CO., and T & CO., individually or collectively, all variations thereof, the distinctive blue coloring often described as 'robin's blue egg' . . . , and any marks or colors that are confusingly similar to those trademarks." Id. at Definitions and Instructions ¶ 4. Each of Tiffany's other discovery requests contains the same definition, and none of these definitions mentions any other trademarks.

7. Exhibit D hereto is a true and correct copy of the non-confidential portion of Defendant's Objections and Responses to Plaintiffs' First Set of Interrogatories (Nov. 22, 2004). eBay's Objections therein state with respect to Tiffany's Interrogatories: "eBay objects to the Interrogatories to the extent that they purport to seek information not pertaining to the Tiffany Marks." Id. at General Objection K. eBay included or otherwise incorporated this objection in each of its sets of responses to discovery requests that purported to seek information beyond the Tiffany Marks.

8. Exhibit E hereto is a true and correct copy of Plaintiffs' Responses and Objections to Defendant's Second Set of Interrogatories (Oct. 7, 2005). In response to Interrogatory No. 18, which asked Tiffany to "[i]dentify which specific activities eBay engages in that Tiffany alleges constitutes direct trademark infringement . . . and which specific activities eBay engages in that Tiffany alleges constitutes contributory trademark infringement," Tiffany responded:

> eBay is well aware of the Tiffany owned trademarks, TIFFANY and TIFFANY & CO., and of the vast goodwill represented and symbolized thereby. Each year, thousands of silver jewelry items sold under and/or bearing the TIFFANY and/or TIFFANY & CO. trademarks that were not manufactured, authorized, sponsored or approved by Tiffany, or otherwise affiliated or connected with Tiffany, are sold through eBay.

Response No. 18. Tiffany referred only to "silver jewelry items" and the "Tiffany" and "Tiffany & Co." trademarks, and Tiffany made no mention of any other trademarks. Tiffany also made no mention of other trademarks in any response to any of eBay's discovery requests.

9. Exhibit F hereto is a true and correct copy of the "Buying Program" Report, dated December 23, 2005, and prepared by George Mantis, an expert retained by Tiffany to attempt to purportedly determine the percentage of listings offering counterfeit Tiffany jewelry posted on the eBay website. The first sentence of that report states that Mantis was retained to "design a program . . . for use in purchasing certain silver jewelry items, offered for sale on eBay, *that use the TIFFANY trademark* as part of the auction titles or descriptions." Id. at 1 (emphasis added). As part of that program, the only listings on the eBay website that were searched were for those that contained the words "Tiffany" and "sterling." The report is silent as to Tiffany's newly-identified trademarks, and it also states that "jewelry packaging" and "jewelry boxes" were "not of interest for [the 'buying program'] protocol." Id. at 2.

10. Exhibit G hereto is a true and correct copy of relevant excerpts of an expert report served on December 30, 2005, and prepared by Gregory Piatetsky-Shapiro, an expert retained by Tiffany to attempt to purportedly determine the feasibility of implementing certain technological features on the eBay website. As part of Piatetsky-Shapiro's assignment, Piatetsky-Shapiro was tasked with "download[ing] all listings with the word 'Tiffany' in the title" on the eBay website. Id. at 10. The report is silent as to Tiffany's newly-identified trademarks.

11. The Joint Pretrial Order filed by the parties on October 6, 2006, addresses only the seven trademarks identified in Tiffany's Complaint and subject to discovery in the litigation. Specifically, the Joint Pretrial Order identifies by name only the "Tiffany," "Tiffany & Co.," and "T & Co." trademarks, see Joint Pretrial Order (Oct. 6, 2006) at 2, and contains a stipulated fact that Tiffany is the owner or exclusive licensee and user of only the seven trademarks identified in Tiffany's Complaint, see id. at 7. The Joint Pretrial Order makes no mention of Tiffany's newly-identified trademarks.

12. The first time that Tiffany indicated that it intended to allege infringement of eleven additional trademarks not previously identified occurred in Tiffany's Proposed Findings of Fact, filed on April 2, 2007, nearly three years into the litigation and well after discovery had closed. These trademarks consist of "Atlas," "Elsa Peretti," "Peretti," and "Paloma Picasso," and variations thereof, as well as four trademarks relating to Tiffany's packaging, advertising, and collateral materials. Tiffany had never previously identified these trademarks.

13. Upon information and belief, a search of the records of the United States Patent and Trademark Office during the week of June 4, 2007, showed that Tiffany currently owns approximately one hundred active trademarks in the United States.

14. This declaration was executed this 8th day of June 2007, in New York, New York.

By: /s/ Randi W. Singer
Randi W. Singer